

ESTTA Tracking number: **ESTTA921761**

Filing date: **09/12/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225722
Party	Defendant inXile Entertainment, Inc.
Correspondence Address	RONALD P OINES RUTAN & TUCKER LLP 611 ANTON BLVD FL 14 COSTA MESA, CA 92626-7681 UNITED STATES trademarks@rutan.com, roines@rutan.com, aspielman@rutan.com, lhul- ley@rutan.com, scook@rutan.com, csolorzano@rutan.com 714-641-5100
Submission	Other Motions/Papers
Filer's Name	Ronald P. Oines
Filer's email	roines@rutan.com, csolorzano@rutan.com, trademarks@rutan.com
Signature	/Ronald P. Oines/
Date	09/12/2018
Attachments	Applicants Trial Brief Public.pdf(619004 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>STEVE JACKSON GAMES INCORPORATED</p> <p>Opposer,</p> <p>v.</p> <p>INXILE ENTERTAINMENT, INC.</p> <p>Applicant.</p>	<p>Opposition No. 91225722</p> <p>Serial No. 86/702,458</p>
---	---

APPLICANT'S TRIAL BRIEF

Ronald P. Oines
Lindsay J. Hulley
RUTAN & TUCKER, LLP
611 Anton Boulevard, Fourteenth Floor
Costa Mesa, CA 92626
Telephone: 714-641-5100
Facsimile: 714-546-9035
roines@rutan.com
lhulley@rutan.com
Attorneys for Applicant inXile Entertainment, Inc.

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	6
II. DESCRIPTION OF THE RECORD	8
A. Evidence Submitted by Opposer.....	8
B. Evidence Submitted by Applicant	8
III. STATEMENT OF ISSUES	9
IV. RECITATION OF FACTS	9
A. Opposer’s Use of “Autoduel” From 1982 to 1996	9
B. Opposer’s Only “Use” of “Autoduel” After 1996 Consisted of Selling Out Inventory and Uploading Copies of Old Publications to Warehouse23.com.....	11
C. Opposer Has Abandoned Its Autoduel Registration and Applications.....	12
D. Applicant’s Bona Fide Intent to Use the Mark and Application Therefor	13
V. ARGUMENT.....	19
A. There Is No Likelihood Of Confusion Between Applicant’s Mark For “Providing Online Downloadable Computer And Video Game Programs; Interactive Video Game Programs” And Opposer’s Mark Used On Supplements To A Thirty-Year Old Board Game Sold Only At Www.Warehouse23.Com	19
1. Opposer’s Mark is Descriptive	19
2. It Is Opposer’s Burden to Establish Likelihood – i.e., a Probability -- of Confusion	20
3. Application of the Pertinent <i>DuPont</i> Factors Confirms There Is No Likelihood of Confusion	20
a. Opposer’s 30 Year Old Game Supplements And Applicant’s Online Downloadable Computer and Video Game Programs and Interactive Video Game Programs Are Not Similar.....	21
b. The Parties’ Respective Trade Channels Are Not Similar.....	23
c. The Parties’ Respective Marks Are Not Identical	24

	<u>Page</u>
d. Consumers Do Not Buy Downloadable Video Games on Impulse.....	24
e. Opposer’s Mark Is Not Famous and Is Very Weak.....	25
f. There Is No Evidence of Actual Confusion.....	26
g. The Possibility of Confusion Is <i>De Minimis</i> , At Most.....	28
B. Applicant Had A Bona Fide Intent To Use “Autoduel” At The Time It Filed Its Application	29
1. It Is Opposer’s Burden to Establish Lack of Bona Fide Intent	29
2. The Evidence Proves Applicant Had a Bona Fide Intent to Use the Mark at the Time of Application.....	30
VI. CONCLUSION.....	32
APPENDIX I	33

TABLE OF AUTHORITIES

Page(s)

FEDERAL CASES

<i>American Home Products Corp. v. Barr Laboratories, Inc.</i> , 834 F.2d 368 (3d Cir. 1987).....	27
<i>Groeneveld Transport Efficiency, Inc. v. Lubecore Intern., Inc.</i> , 730 F.3d 494 (6th Cir. 2013)	27
<i>In re E.I. DuPont de Memours & Co.</i> , 476 F.2d 1357 (CCPA 1973)	7, 20
<i>In re National Data Corporation</i> , 753 F.2d 1056 (Fed. Cir. 1985).....	24
<i>Kelly Services, Inc. v. Creative Harbor, LLC</i> , 846 F.3d 857 (6th Cir. 2017)	29
<i>Nora Beverages, Inc. v. Perrier Group of America, Inc.</i> , 269 F.3d 114 (2d Cir. 2001).....	26, 27
<i>Toyota Motor Sales, USA, Inc. v. Tabari</i> , 610 F.3d 1171 (9th Cir. 2010)	24, 25

TRADEMARK TRIAL AND APPEAL BOARD

<i>Alliance Technical Services, Inc. v. Alliance Machine Systems International, Inc.</i> , 2006 WL 2558023, *14 (Trademark Tr. & App. Bd. 2006).....	28
<i>Alpharma Inc. v. Advanced Animal Nutrition, Inc.</i> , 2009 WL 273252, *10 (Trademark Tr. & App. Bd. 2009).....	28
<i>Boston Red Sox Baseball Club Limited Partnership v. Sherman</i> , 88 U.S.P.Q.2d 1581, 2008 WL 4149008, at *6 (Trademark Tr. & App. Bd. 2008)	29
<i>Commodore Electronics Ltd. v. CBM Kabushiki Kaisha</i> , 1993 TTAB LEXIS 6, 26 USPQ2d (BNA) 1503 (Trademark Tr. & App. Bd. 1993).....	31
<i>In re Fesco Inc.</i> , 219 USPQ 437, 1983 WL 50157, * 1 (Trademark Tr. & App. Bd. 1983)	7, 9, 22, 23
<i>In re Iron Hill Brewery, LLC</i> , Serial no. 86682532 (Trademark Tr. & App. Bd. July 28, 2017) (non-precedential), at pg. 15).....	22
<i>In re J.G. Julian Toys, LLC</i> , Appeal No. 78916820 (Trademark Tr. & App. Bd. June 25, 2008)	22

TRADEMARK TRIAL AND APPEAL BOARD (CONT.)

<i>Justin Vineyards & Winery LLC v. Crooked Stave, LLC</i> , Opposition no. 91229132 (Trademark Tr. & App. Bd. June 26, 2018) (non-precedential), at pg. 5).....	20
<i>Lane Limited v. Jackson International Trading Company</i> , 1994 WL 740491, 33 U.S.P.Q.2d (BNA) 1351, 1353 (Trademark Tr. & App. Bd. 1994).....	30, 31
<i>Market America, Inc. v. Luciano Sztulman M.D., Inc.</i> , 2018 WL 2721906 (Trademark Tr. & App. Bd. 2018).....	31
<i>Trek Bicycle Corporation v. Celestron Acquisition LLC</i> , 2018 WL 529850 (Trademark Tr. & App. Bd. 2018).....	23
<i>Ziebarth v. Del Taco, LLC</i> , 2015 TTAB LEXIS 324, *44 (Trademark Tr. & App. Bd. 2015)	21

TREATISES

3 Anne Gilson LaLonde, <i>Gilson on Trademarks</i> § 3.04[2][d] (Matthew Bender).....	30
4 McCarthy on Trademarks & Unfair Competition § 23:3 (5th ed.).....	20
4 McCarthy on Trademarks and Unfair Competition § 23:9 (5th ed.).....	27

I. INTRODUCTION

Origin Systems, a licensee of Opposer, sold an “Autoduel” video game for a few years approximately thirty years ago. (25 TTABVUE Ex. 13, pg. SJG001988.) Neither Opposer nor any licensee has ever used “Autoduel” for any other video game. Despite this clear abandonment of the Autoduel mark for video games, and its abandonment of all registrations and applications for “autoduel,” Opposer seeks to prevent Applicant from using “Autoduel” for “[p]roviding online downloadable computer and video game programs [and] [i]nteractive video game programs” based on Opposer’s alleged common law rights.

Opposer has not used the Autoduel mark on anything new since 1996. (25 TTABVUE Ex. 13.) Opposer’s *only* “uses” of the Autoduel mark in the past twenty or so years consist of its selling out its inventory of “Autoduel Quarterly” and other supplements to its Car Wars board game. (*Id.*) Hard copy inventory of nearly all of the Autoduel Car Wars supplements were sold out in the 1980s and 1990s. (*Id.*) Since 2006, with a *de minimis* exception,¹ the *only* sale of any products bearing “autoduel” were digital copies of twenty to thirty year old back issues of Car Wars supplements. (*Id.*) Moreover, until just recently,² the *only place* one could encounter and purchase those back issues was on Opposer’s “Warehouse23” website. (25 TTABVUE 9-10, ¶¶ 24-26.)

In denying Opposer’s motion for summary judgment on the issue of likelihood of confusion, the Board held that there are genuine issues of fact as to the goods for which Opposer can establish priority. (18 TTABVUE 5.) Applicant submits the only goods for which Opposer arguably can establish priority are the pdf versions of the twenty to thirty year old back issues of Autoduel Quarterly and other Car Wars supplements, all of which were available *only* on Opposer’s Warehouse23 website.

¹ Apparently Opposer sold a total of 51 of its Volume 7 Road Atlas from 2007 to 2012. (*Id.*)

² Mr. Reed testified at his deposition on March 22, 2018 that within the last couple of months prior to his deposition, some of the back issues available on www.warehouse23.com were also available on www.drivethrurpg.com. (39 TTABVUE 43:19-44:8.) Opposer has not submitted any evidence of sales through this site.

Opposer seems to believe confusion is likely simply based on its contention that the marks are identical and the parties' respective goods relate generally to gaming. However, the Board long ago rejected such a simplistic approach. See, e.g., *In re Fesco Inc.*, 219 USPQ 437, 1983 WL 50157, * 1 (Trademark Tr. & App. Bd. 1983) (“[T]he Board has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties.”)

As explained below, in light of the undisputed facts and application of the pertinent *DuPont* factors, Opposer has not established likelihood of confusion here.

Opposer attempts to argue that Applicant acted with bad intent in deciding to use “autoduel” for its video game, and for applying for a trademark registration, but the evidence shows that the facts of which Mr. Fargo was aware would lead any reasonable person to conclude that any rights Origin Systems or Opposer may have once owned in the autoduel mark had long since been abandoned.

As explained below, Applicant acted in good faith in deciding to move forward with a video game called “autoduel” and had a bona fide intent to use the mark at the time Applicant filed its application, as evidenced by the uncontradicted testimony and numerous documents submitted with Applicant’s evidence.

Applicant respectfully submits that Opposer’s Opposition should be dismissed, and Applicant’s application should proceed to issuance.

II. DESCRIPTION OF THE RECORD

A. Evidence Submitted by Opposer

Opposer has made the following testimony of record:

Testimonial Declaration of Phil Reed with Exhibits 1 through 32. (Confidential version 25 TTABVUE; Public version 26 TTABVUE).

Opposer has filed the following Notices of Reliance:

Opposer's Notice of Reliance on Internet Materials with Exhibits 33 through 42. (27 TTABVUE).

Opposer's Notice of Reliance on Discovery Responses with Exhibits 43 and 44. (28 TTABVUE).

Opposer's Notice of Reliance on Official Records with Exhibits 45 through 51. (29 TTABVUE).

Opposer's Notice of Reliance on Discovery Depositions with Exhibits 52 and 53. (Confidential version 30 TTABVUE; Public version 31 TTABVUE).

B. Evidence Submitted by Applicant

Applicant has made the following testimony of record:

Applicant's Notice of Submission of Testimony Deposition of Phillip Reed with Exhibits A, B, C, 34 and 37. (Confidential version 39 TTABVUE; Public version 38 TTABVUE).

Testimonial Declaration of Brian Fargo with Exhibits 54 through 62. (Confidential version 37 TTABVUE; Public version 36 TTABVUE).

Applicant has filed the following Notices of Reliance:

Applicant's Notice of Reliance on Official Records with Exhibits 63 through 76. (33 TTABVUE).

Applicant's Notice of Reliance on Discovery Depositions with Exhibits 77 through 93. (Confidential version 35 TTABVUE; Public version 34 TTABVUE).

III. STATEMENT OF ISSUES

A. Whether Applicant had a bona fide intent to use the Autoduel mark at the time it filed its Application on July 23, 2015.

B. Whether Applicant's "Autoduel" mark for "[p]roviding online downloadable computer and video game programs [and] [i]nteractive video game programs" is likely to cause confusion or mistake, or to deceive in light of Opposer's common law rights in "Autoduel."

C. "[T]he goods for which Opposer can demonstrate priority." (See Board's Order on Motion for Summary Judgment, 18 TTABVUE 5.)

D. "[T]he relatedness of the parties' goods." (*Id.*)

E. "[T]he fame of Opposer's mark." (*Id.*)

F. "[W]hether there has been actual confusion in the marketplace." (*Id.*)

IV. RECITATION OF FACTS

A. Opposer's Use of "Autoduel" From 1982 to 1996.

Opposer used the word "autoduel" in connection with its Car Wars role playing game. Opposer released Car Wars in about 1980 or 1981. Car Wars was in the format of a book, and it was sold through the mail, in hobby stores and in book stores. (35 TTABVUE Ex. 77, 18:12-19:16)

Opposer first used "autoduel" in 1982 on packaging for miniature metal cars. (35 TTABVUE Ex. 77, 25:14-22.) These cars could be used with Car Wars or any other game. (35 TTABVUE Ex. 77, 25:11-18.) Although Opposer believes these miniature cars were sold for about five years, "give or take two years," (35 TTABVUE Ex. 77, 28:6-29:19) there is no real evidence that the miniature cars were sold later than 1982.

In 1983, Opposer published Autoduel Champions, which was a role playing book designed to allow players to play Opposer's Car Wars game using the Champions' rule set. (Opposer's Trial Brief ["Opp. Br."], pg. 10; 35 TTABVUE Ex. 78, 32:24-34:7.) There is no evidence that Autoduel Champions was sold after 1983.

Opposer published Autoduel Quarterly from 1983 to 1992. (25 TTABVUE Ex. 13.) Autoduel Quarterly was a supplement for the Car Wars game. (35 TTABVUE Ex. 77, 18:9-11; Ex. 80, 41:5-42:2.) Autoduel Quarterly was a quarterly magazine that pretended to be written fifty years in the future and was dedicated to the practice of vehicular combat. (35 TTABVUE Ex. 77, 23:1-21.)

There is no evidence that any hard copy issues of Autoduel Quarterly were ever sold after 1992. (25 TTABVUE Ex. 13.) Opposer has stated that “Autoduel Quarterly Issue 10/4 was published in the Winter of 1992, and was the last issue of ADQ ever. After this issue, coverage of Car Wars would continue in Pyramid magazine. Autoduel Quarterly went out with a bang” (35 TTABVUE Ex. 80, pg. SJG000948.)

Although Opposer has never used “autoduel” in connection with computer games, Origin Systems, pursuant to license from Opposer, published an Autoduel video game, which was available from 1985 to 1988. (Opp. Br. pg. 10.)

In 1986, Opposer published a Car Wars role-playing book with the title “GURPS Autoduel.” (Opp. Br. pg. 4.) GURPS Autoduel was sold until 1989. (25 TTABVUE Ex. 13.)

From 1987 to 1988, Opposer published volumes one through seven of the AADA Road Atlases. (25 TTABVUE Ex. 13.) Opposer did not use the word “autoduel” to identify the atlases, but only noted that the atlases were supplements to Car Wars and GURPS Autoduel. (25 TTABVUE Ex. 8.)³

Opposer published GURPS Autoduel Car Warriors, Zombietown USA, and Autoduel America maps in 1987, 1988 and 1989, respectively. (Opp. Br. pg. 10.)

The next and last time Opposer published new material using “autoduel” was in 1996 when Opposer published GURPS Autoduel, second edition. (Opp. Br. pg. 11.) As of 1996, however, it appears Opposer no longer believed it had trademark rights in “autoduel.” Prior to

³ It should be noted that on the cover of these road atlases, Opposer’s use of an “®” with “autoduel” was improper. The only registration Opposer ever owned (now abandoned) was for “Autoduel!” for “miniature figures for use with a parlour game sold separately.” (25 TTABVUE, Ex. 1.)

that time, Opposer had placed ® or ™ next to “autoduel.” (25 TTABVUE Exs. 7, 8 and 9.) With the publication of GURPS Autoduel, second edition, however, Opposer used an ® with GURPS, but no trademark notice with “autoduel.” (25 TTABVUE Ex. 12.)

B. Opposer’s Only “Use” of “Autoduel” After 1996 Consisted of Selling Out Inventory and Uploading Copies of Old Publications to Warehouse23.com.

After 1996, Opposer no longer created new material using “autoduel.” Opposer’s only “uses” after 1996 consisted entirely of selling out old inventory of a few items and the uploading in around 2005 to its Warehouse 23 website of archived back issues of its previous publications. Not surprisingly, given Opposer’s lack of use of the mark, Opposer allowed its registration for “AUTODUEL!” to be cancelled. (25 TTABVUE 2, ¶ 4.)

In its Trial Brief, Opposer states that it sold physical “autoduel” gaming products until 2012. (Opp. Br. pg. 12.) This statement is misleading. There is no evidence of any sales of Autoduel publications after 1992, except Opposer claims it sold out the following limited amounts of stock of old materials: (1) it sold out its stock of GURPS Autoduel, second edition, from 1996 to 2003, (2) it sold four each of volumes two, three, four and five of the road atlases in 2004, and (3) it sold an average of about ten per year until 2012 of volume seven of the 1988 Road Atlas. (25 TTABVUE Ex. 13.) That’s it! And as stated above, Opposer did not use the word “autoduel” to identify the road atlases, but only noted that the atlases were supplements to Car Wars and GURPS Autoduel.

In 2005, Opposer apparently started making archive copies of Autoduel Quarterly available as HTML or PDF files, not on its website at www.sjgames.com, but on a “warehouse” website, www.warehouse23.com. As the name implies, this is where Opposer warehoused its old publications. Opposer has acknowledged that it was done using the autoduel name, and was merely providing archived copies of old materials on the Warehouse 23 website. Indeed, in 2014, a Car Wars archivist asked if Opposer could put a PDF of the GURPS Autoduel, first edition, on the Warehouse 23 website. Opposer replied: “I’ll see what we’re able to do although

I admit that it'll be a lower priority, since it'll likely involve poking through corners of archives that haven't witnessed the light of day in many a year . . ." (35 TTABVUE Ex. 92, pg. INX000065.)

Opposer has never used "autoduel" in connection with online downloadable computer or video games. (35 TTABVUE Ex. 82, pg. 59:12-16). In fact, Opposer has never sold anything downloadable using "autoduel" except "downloadable PDFs of back issues of publications." (35 TTABVUE, Ex. 93, pg. 91:12-16.)⁴

C. Opposer Has Abandoned Its Autoduel Registration and Applications.

Given that Opposer stopped using "autoduel" in the mid-1990s, it is not surprising that Opposer allowed its registration for "AUTODUEL!" to be cancelled. Opposer never sought to obtain a registration for autoduel after its initial filing for the miniature metal cars until a third party recently sought to register "autoduel." In particular, Big Boat Interactive ("BBI") filed an intent to use application for "AUTODUEL" for "computer game software for personal computers and home video game consoles." (33 TTABVUE Ex. 66.) When Opposer found out about this, Opposer objected to use of the name "Autoduel" and filed an Opposition to BBI's application for registration. Pixelbonic/BBI decided it was easier to change the name than dispute the trademark issues over "Autoduel." (*Id.*)

On May 23, 2013, apparently due to BBI's filing, Opposer filed an application to register "AUTODUEL" for "digital, downloadable, or electronic media; namely, text and graphic files of rules, maps, components, and supplements for family games, boardgames, and roleplaying

⁴ Opposer asserts that it received an inquiry in 2015 "regarding potentially licensing the AUTODUEL mark for a new video game." (25 TTABVUE, pg. 8, ¶ 21.) Applicant has included objections to this evidence in Appendix I hereto, as the evidence is hearsay. In any event, even if the Board were to consider this evidence, nothing in the referenced email indicates that the person inquiring wished to license a trademark. In fact, it is clear that person was inquiring about licensing *content* from Origin Systems' old autoduel game, as he was thinking of developing a game [REDACTED] (25 TTABVUE Ex. 17.) In any event, whether someone reached out to Opposer to license content or anything else relating to autoduel is irrelevant to this matter.

games.” (25 TTABVUE 14, ¶ 43.) Opposer claimed a first use in commerce of January 6, 2005, which presumably referred to the time when the archived back issues were made available on the Warehouse23 website. (*Id.*) In any event, Opposer abandoned its application. (25 TTABVUE 14, ¶ 44.)

Applicant filed its application on July 23, 2015. At some point thereafter, Opposer became aware of Applicant’s application and, internally, acknowledged that Opposer had intentionally abandoned its May 23, 2013 application. Opposer’s Trademark Administrator, upon learning of Applicant’s application sent an email to Phil Reed, CEO of Opposer, stating:

██
██
██

████████████████████ (35 TTABVUE Ex. 85, pg. SJG001244; emphasis added.)⁵

On November 2, 2015, Opposer filed another application for the exact same goods as the May 23, 2013 application and filed it as an “intent to use” application, thus explicitly acknowledging that it did not believe the uploading of the pdfs of old back issues was a use of the mark. (33 TTABVUE Ex. 63.)

**D. Applicant’s Bona Fide Intent to Use the Mark and Application
Therefor.**

Applicant is a well-known computer gaming company that was founded by a legend in the computer gaming industry, Brian Fargo. Mr. Fargo started his first computer gaming company while in high school and released his first game in 1981, the year he graduated high

⁵ Opposer’s assertion that its abandonment of its mark and application were “inadvertent” is belied by the facts. First, the email quoted above acknowledges that ██████████. Second, Opposer knew the application was going to be abandoned because, at first, Opposer revived the application, but thereafter ██████████ (35 TTABVUE Ex. 91, pgs. 66:25-67:17.) Moreover, at around that same time, Ms. Zakes of Opposer filed many documents with the Trademark Office regarding Opposer’s other marks. (33 TTABVUE, Ex. 68 [Trademark Application filed February 5, 2014]; Ex. 69 [Trademark Application filed February 24, 2014]; Ex. 70 [Combined Declaration filed August 11, 2014]; Ex. 71 [Combined Declaration filed November 25, 2014]; Ex. 72 [Trademark Application filed March 9, 2015]; Ex. 73 [Statement of Use filed March 30, 2015].) Opposer actively monitored its trademarks during 2014 and 2015. It strains credulity to argue that Opposer ██████████ inadvertently.

school. (37 TTABVUE 1, ¶ 2.) Mr. Fargo founded Applicant in 2002. (*Id.*) Applicant has released nineteen games since 2002, the most recent being Tides of Numenera and The Mage's Tale. (37 TTABVUE 1, ¶ 3.) Tides of Numenera was released on February 28, 2017 and The Mage's Tale was released on June 20, 2017. (37 TTABVUE 1-2, ¶ 3.) The time from conception to actual release typically lasts at least a few years and can last up to several years. (37 TTABVUE 2, ¶ 3.) After Mr. Fargo decides to create a new game at Applicant, broad ideas for the game are exchanged among Mr. Fargo, the creative people, and game designers before the game actually goes into production. (*Id.*) This process can last many months and sometimes more than a year, depending in part on what other games are in production at the time and what resources are available. (*Id.*) Exchanging and discussing broad concepts for a new game freely and without deadlines before moving deep into production allows the team at Applicant to think creatively about the game, without the pressure of incurring significant costs associated with the actual production of the game. (*Id.*) This process is fairly typical in the computer gaming industry. (*Id.*)

At any given time, Applicant normally has a pipeline of two or three games, although most of the company's time is focused on the development of the next to be released game. (37 TTABVUE 2, ¶ 4.) While it does the enormous amount of work necessary to finish a game for release, Applicant also has another game or two in the discussion and/or design stages. (*Id.*) In 2015, Applicant was very busy working to finalize and release Wasteland 2: Director's Cut. (*Id.*) Through 2016 and into 2017, Applicant was very busy working on Torment: Tides of Numenera (which was released on February 28, 2017), The Mage's Tale (which was released on June 20, 2017) and The Bard's Tale IV, which Applicant continues to work on. (*Id.*)

This Opposition proceeding involves Applicant's intent to use application for "AUTODUEL" for "[p]roviding online downloadable computer and video game programs; Interactive video game programs." (37 TTABVUE 2, ¶ 5.) At the time Applicant filed its application on July 23, 2015, Mr. Fargo was generally aware of the Origin Systems Autoduel computer game from the 1980s, but he knew that game had not been available for more than 20

years. (*Id.*) Mr. Fargo was not aware of any of Opposer's prior uses of Autoduel in connection with its Car Wars game supplements, although he has become aware of those as a result of this Opposition proceeding. (*Id.*)

At some point in 2013, Mr. Fargo became aware that a company called Big Boat Interactive had filed an intent to use application for "AUTODUEL" for "computer game software for personal computers and home video game consoles." (37 TTABVUE 3, ¶ 6.) At the time Mr. Fargo learned of this, Maxx Kaufman was with Pixelbonic, which was working on a Kickstarter campaign with Big Boat Interactive for a computer game they intended to call "Autoduel." (*Id.*) Mr. Fargo learned from Mr. Kaufman that Opposer objected to use of the name "Autoduel" and filed an Opposition to Big Boat Interactive's application for registration. (*Id.*) Mr. Fargo learned that Pixelbonic/Big Boat interactive decided it was easier to change the name than dispute the trademark issues over "Autoduel." (*Id.*) At the time, Mr. Kaufman was also working part-time for Applicant, but Applicant was not involved in the Pixelbonic/Big Boat Interactive Kickstarter project. (*Id.*) Mr. Kaufman discussed the issues with Mr. Fargo, at which time Mr. Fargo told Mr. Kaufman he thought Mr. Kaufman should pursue use of "Autoduel" because Mr. Fargo believed Opposer did not own trademark rights in that term. (*Id.*)

During that time period, Mr. Fargo learned from searching the USPTO website that Opposer had long ago abandoned its only registration for "AUTODUEL!" (37 TTABVUE 3, ¶ 7.) At some point, Mr. Fargo also learned that on May 23, 2013, apparently due to Big Boat Interactive's trademark application filing, Opposer filed an application to register "AUTODUEL" for "digital, downloadable, or electronic media; namely, text and graphic files of rules, maps, components, and supplements for family games, board games, and roleplaying games." (*Id.*) However, on March 31, 2014, the Trademark Office issued a Notice of Abandonment of Opposer's trademark application and, although the application was temporarily revived, the Trademark Office issued another Notice of Abandonment on November 28, 2014. (37 TTABVUE 4, ¶ 8.)

Based on the information of which Mr. Fargo was aware, as of shortly before July 23, 2015, he knew Origin Systems had stopped selling the computer game Autoduel more than 20 years earlier, and that Opposer had abandoned all trademarks and trademark applications for “AUTODUEL.” (37 TTABVUE 4, ¶ 9.) Mr. Fargo was aware of no other uses of “AUTODUEL” by anyone. (*Id.*) As of shortly before July 23, 2015, Mr. Fargo understood that the mark “AUTODUEL” was available. (*Id.*)

Applicant has considered for many years the possibility of developing a post-apocalyptic computer game that would include battling vehicles. (37 TTABVUE 4, ¶ 10.) This is a fairly popular genre whose themes have been in popular movies such as the Mad Max franchise. (*Id.*) In 2015, Mr. Fargo decided to proceed with the design and development of such a game, and after he confirmed that “Autoduel” was available for a name, he decided to name the game “Autoduel.” (*Id.*)

Applicant filed its intent to use application in the United States on July 23, 2015. (37 TTABVUE 4, ¶ 11.) Applicant has also filed trademark applications for “Autoduel” in Australia, Canada, China, South Korea and the European Union. (*Id.*) Registrations for Autoduel have been issued to Applicant in China, South Korea and the European Union. (*Id.*) The applications in Australia and Canada are pending. (*Id.*)

Shortly after Applicant filed the application in the United States, a website that covers the gaming industry, apparently learned of Applicant’s trademark filing and wrote a note about it. (37 TTABVUE 4, ¶ 12.) Others who cover the industry picked up on the note. (*Id.*) After PC Gamer wrote an article about Applicant’s trademark application on October 22, 2015, the Redner Group, which does public relations for Applicant, received a request for a comment about Applicant’s plans for the AUTODUEL game. (*Id.*) At that time, Mr. Fargo informed Redner Group that it was too early to comment. Mr. Fargo does not typically comment on games that are early in the design process. (*Id.*)

At Applicant, much of the design process involves informally and verbally sharing ideas and concepts for the games that are planned. (37 TTABVUE 5, ¶ 13.) Applicant does not create

a lot of documents in the early stages. (*Id.*) Nonetheless, Applicant has produced several documents in this case that confirm Applicant's intent to use "Autoduel." (*Id.*)

Exhibit 55 is copy of a November 11, 2015 email from Mr. Fargo to others listed at Applicant. (37 TTABVUE 5, ¶ 14, Ex. 55.) In that email, Mr. Fargo forwarded an article he had read on a gaming industry website, and commented to his design and development team: "It will be a fine line we walk with Autoduel for mobile when we decide to start designing it." (*Id.*) Mr. Fargo was referring to a mobile phone version of Autoduel, which is one of the versions of the Autoduel game Applicant was and is considering. (*Id.*)

Exhibit 56 is a copy of an email from Eric Daily to Mr. Fargo dated December 4, 2015. (37 TTABVUE 5, ¶ 15, Ex. 56.) Mr. Daily is and was at the time a Producer at Applicant. (*Id.*) In his email, which has the subject line "Wasteland: Autoduel mobile," Mr. Daily refers to a conversation he overheard between Mr. Fargo and George Ziets, who was at the time and is a lead writer at Applicant, about a mobile vehicular combat game, i.e., Autoduel. (*Id.*) Mr. Daily was giving Mr. Fargo some ideas for the Autoduel game Applicant was and is planning. (*Id.*)

Exhibit 57 is a copy of an email exchange on January 11, 2016 between Chris Keenan, who is and was at the time Vice President of Development at Applicant, and Mr. Fargo regarding the "mobile focused Autoduel product." (37 TTABVUE 6, ¶ 16, Ex. 57.)

Exhibit 58 is a copy of a January 19, 2016 email from Thomas Beekers to Mr. Fargo. Mr. Beekers was and is Creative Producer at Applicant. (37 TTABVUE 6, ¶ 17, Ex. 58.) Mr. Beekers forwarded some articles from the trade press regarding marketing initiatives. (*Id.*) He noted "I suspect if we do wind up crafting a smaller title for mobiles in AutoDuel we'll have to heavily explore a lot of this more creative marketing" (*Id.*)

Exhibit 59 is a copy of a February 18, 2016 email from Mr. Keenan to Mr. Fargo. (37 TTABVUE 6, ¶ 18, Ex. 59.) Mr. Keenan forwarded an article to Mr. Fargo about "where the industry is headed" and noted: "Certainly will need to keep this in mind for Autoduel though." (*Id.*)

Exhibit 60 are email exchanges between persons at Pixel Dash Studios and persons at Applicant from April 5 through April 12, 2016. (37 TTABVUE 6, ¶ 19, Ex. 60.) The emails refer to a proposal Pixel Dash made to Applicant for Autoduel. (*Id.*) Pixel Dash is an outside studio that was aware of Applicant's plans for Autoduel and made the proposal in an effort to work with Applicant on Autoduel. (*Id.*) Pixel Dash's April 5, 2016 proposal is also attached as part of Exhibit 60. (*Id.*) One of the emails from Matt Findley of Applicant notes that Mr. Findley had talked to Mr. Fargo about Pixel Dash's proposal for Autoduel, and Mr. Findley was forwarding Mr. Fargo's general comments on their proposal. (*Id.*)

Exhibit 61 is an email Mr. Fargo received from Mr. Beekers on May 30, 2016, with which he attached a "pitch" for his ideas for the Autoduel game. (37 TTABVUE 6, ¶ 20, Ex. 61.) The thirteen page pitch is also attached as part of Exhibit 61. (*Id.*)

On January 5, 2017, Mr. Daily sent Mr. Fargo an email with some thoughts about using "Autoduel" and possibly including independent developers. (37 TTABVUE 6, ¶ 21, Ex. 62.) At that time, Applicant was approaching the release of Torment, so it would be normal for Mr. Daily to be thinking about other projects in the pipeline to turn his attention to. (37 TTABVUE 6-7, ¶ 21.) On that same day, Mr. Fargo responded to Mr. Daily, indicating that Mr. Beekers had already prepared an initial design for Autoduel and that Applicant would bring Mr. Daily into the loop. (37 TTABVUE 7, ¶ 21, Ex. 62.)

Applicant completed and released Torment on February 28, 2017. (37 TTABVUE 7, ¶ 22.) This freed up resources at Applicant to focus on moving forward with other games in the pipeline. (*Id.*) Shortly after the release of Torment, Mr. Fargo formally assigned Mr. Daily as the Producer of Autoduel at Applicant. (*Id.*) Thereafter Mr. Fargo assigned Thomas Beekers to be the Designer of Autoduel. (*Id.*) Autoduel is now one of four new games Applicant is working on. (*Id.*) Applicant's recent work on Autoduel has included researching other games in the market, continuing work on design and design documents, and continuing work on concept and concept art. (*Id.*)

Applicant intended to use “Autoduel” for its game on July 23, 2015, and still intends to use it. (37 TTABVUE 7, ¶ 23.) Applicant’s application for registration for “Autoduel” is for “[p]roviding online downloadable computer and video game programs; Interactive video game programs.” (37 TTABVUE 8, ¶ 25.) Like Applicant’s other games, its Autoduel game will be sold through third party gaming sites, such as iTunes and Steam. (*Id.*)

V. ARGUMENT

A. There Is No Likelihood Of Confusion Between Applicant’s Mark For “Providing Online Downloadable Computer And Video Game Programs; Interactive Video Game Programs” And Opposer’s Mark Used On Supplements To A Thirty-Year Old Board Game Sold Only At Wwww.Warehouse23.Com.

1. Opposer’s Mark is Descriptive.

To begin with, Opposer has not established that its mark is distinctive. Opposer relies entirely on its abandoned registration and application as evidence that its “autoduel” mark is inherently distinctive. However, Opposer’s Opposition is based on Opposer’s alleged common law rights in “autoduel,” not on any registration.

The evidence shows that, to the extent Opposer ever used “autoduel” as a trademark, it ceased such use long ago. Indeed, the evidence shows that Opposer uses “autoduel” in a descriptive sense, not as a trademark. Opposer acknowledges that “autoduel” describes a sport that is played in the CAR WARS game in which “autos” “duel.” (35 TTABVUE, Ex. 89, pg. 24:3-17.) Opposer’s more recent kickstarter campaign further shows that Opposer does not intend to use “autoduel” as a trademark. Opposer’s proposed boardgame was entitled “Car Wars Arenas.” (25 TTABVUE 2-3, ¶ 5.) During his deposition, Mr. Reed testified that “Car Wars Arenas” is “extremely descriptive” and people know that you can do “autoduelling” in these arenas, i.e., using autos to duel. (35 TTABVUE, Ex. 93, pgs. 89:7-90:20)

Opposer has not established that its “autoduel” mark is distinctive. Based on this alone, the Opposition should be dismissed. At a minimum, as explained below, even if Opposer’s mark is distinctive, Opposer’s mark is very weak and entitled to limited protection.

2. It Is Opposer’s Burden to Establish Likelihood – i.e., a Probability -- of Confusion.

Opposer bears the burden of proving likelihood of confusion by a preponderance of the evidence. *Justin Vineyards & Winery LLC v. Crooked Stave, LLC*, Opposition no. 91229132 (Trademark Tr. & App. Bd. June 26, 2018) (non-precedential), 22 TTABVue at pg. 5.

“Likelihood of confusion is synonymous with ‘probable’ confusion – it is not sufficient if confusion is merely ‘possible.’” 4 McCarthy on Trademarks & Unfair Competition, § 23:3 (5th ed.)

3. Application of the Pertinent *DuPont* Factors Confirms There Is No Likelihood of Confusion.

In analyzing likelihood of confusion, the Board considers the pertinent factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). Applicant submits that the pertinent factors in this case are: “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use”; “[t]he similarity or dissimilarity of established, likely-to-continue trade channels”; “[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression”; “[t]he conditions under which and buyers to whom sales are made, i. e. ‘impulse’ vs. careful, sophisticated purchasing”; “[t]he fame of the prior mark (sales, advertising, length of use)”; “[t]he nature and extent of any actual confusion”; and “[t]he extent of potential confusion, i. e., whether *de minimis* or substantial.” *DuPont*, 476 F.2d at 1361.

**a. Opposer's 30 Year Old Game Supplements And
Applicant's Online Downloadable Computer and Video
Game Programs and Interactive Video Game Programs
Are Not Similar.**

“The Lanham Act was not intended to provide a warehouse for unused marks.” *Ziebarth v. Del Taco, LLC*, 2015 TTAB LEXIS 324, *44 (Trademark Tr. & App. Bd. 2015)(quoting *Imperial Tobacco v. Phillip Morris*, 14 USPQ2d 1390, 1394 (Fed. Cir. 1990). Although the Board found that Opposer had not abandoned rights as to all of Opposer's goods, Applicant submits that the evidence establishes Opposer long ago abandoned any rights to Autoduel for video games.

The evidence establishes that the only goods for which Opposer can argue priority are the supplements to Opposer's Car Wars game, such as the Autoduel Quarterly magazines from the 1980s and early 1990s. Other than uploading digital versions of old supplements to Car Wars, Opposer has not used the mark for some twenty years.

Opposer's conduct vis-a-vis the trademark office shows that Opposer admits it has no trademark rights, other than with respect to its uploading of back issues of supplements. And even as to the uploading of back issues, the fact that Opposer filed an “intent to use” application shows that Opposer did not even believe such uploading constituted “use.” As explained above, Opposer's registration for “AUTODUEL!” for miniature metal cars was cancelled long ago. Opposer has never owned any other registration for “autoduel.” However, in 2013, Opposer objected to another party's intent to use application for “autoduel” for computer games and, in connection therewith in May of 2013, filed its own application to register “autoduel” for “digital, downloadable, or electronic media; namely, text and graphic files of rules, maps, components, and supplements for family games, boardgames, and roleplaying games.” Opposer claimed a first use in commerce of January 6, 2005, which apparently referred to the time when the archived back issues were made available in pdf format on the website. In any event, Opposer

abandoned that application. (25 TTABVUE 14, ¶ 44.) As noted above, Opposer’s claim that the abandonment was “inadvertent” strains credulity.

After Opposer became aware of Applicant’s application, Opposer filed another application for the exact same goods as the May 23, 2013 application and filed it as an “intent to use” application, thus explicitly acknowledging that it did not believe the uploading of the pdfs of old back issues was a use of the mark. (33 TTABVUE Ex. 63.)

In this case, Opposer has failed to meet its burden to establish that the parties’ respective goods are similar. In fact, Opposer has failed to submit any evidence that written supplements to a board game are similar or related to downloadable computer games. See, e.g., *Justin Vineyards*, supra, pgs. 10-13. (Board held no likelihood of confusion, including because opposer failed to submit evidence that beer and wine are related). *In re Iron Hill Brewery, LLC*, Serial no. 86682532 (Trademark Tr. & App. Bd. July 28, 2017) (non-precedential) 19 TTABVUE at pg. 15 (In considering identical marks, Board found no likelihood of confusion, including because beer and restaurant services are not related).⁶

In *In re Fesco Inc.*, supra, a case involving “virtually identical” marks, the Board found that any likelihood of confusion was remote because applicant’s mark was used in connection with farm equipment and machinery distribution, and the mark in the cited registration was used

⁶ The case Opposer relies on, *In re J.G. Julian Toys, LLC*, Appeal No. 78916820, 11 TTABVUE (Trademark Tr. & App. Bd. June 25, 2008)(non-precedential), is distinguishable. In that case, the mark at issue was used as the name of the board game itself. Here, Opposer’s mark is merely used in connection with supplements to a board game. Additionally, in *In Re J. G. Julian*, the senior registration was for numerous goods, comprising: “Computer game software; electronic publications, namely magazines in the field of computer games downloadable from computer networks; computer game software downloadable from computer networks; video game software for home use downloadable from computer networks; video game software for home use, in International Class 9; Magazines in the field of computer games and video games; video game strategy guidebooks; stationery; photographs; photograph stands; trading cards, in International Class 16; LCD game machines; hand-held game apparatus with liquid crystal displays; dolls, in International Class 28; and Providing on-line games via computer networks; providing information relating to computer games via computer networks, in International Class 41.” In this matter, on the other hand, Opposer’s rights stem from the sale of only twenty to thirty year old back issues of game supplements on a single website.

for processing equipment and machinery, including machinery used in fertilizer processing.
1983 WL 50157, * 1.

Opposer's argument that a downloadable video game called "Autoduel" is within the zone of natural expansion for its Car Wars supplements is unpersuasive, and Opposer has submitted no evidence to support it. *Trek Bicycle Corporation v. Celestron Acquisition LLC*, 2018 WL 529850 (Trademark Tr. & App. Bd. 2018) (non-precedential). As was the case in *Trek Bicycle*, the Opposer's zone of expansion argument here fails. Downloadable video game software involves new and different technology than written board game supplements. *Id.* at *11. The nature and purpose of the goods are different. *Id.* As explained below, the channels of trade and classes of customer are different. *Id.* And there is no evidence that other companies have expanded from board game supplements to downloadable video game software. *Id.*

Nor is there any evidence to support Opposer's contention that it has actually considered such expansion. Indeed, even when it was challenging Big Boat Interactive's application for "Autoduel" and Applicant's application for "Autoduel," the applications Opposer filed (one as an intent to use application) were limited to "[d]igital media and electronic media, namely, downloadable text and graphic files featuring rules, maps, components and supplements for family games, board games, and roleplaying games." (25 TTABVue 14, ¶¶ 43, 45.) The fact that Opposer licensed the use of Autoduel for a video game 30 years ago is irrelevant.

Applicant submits that this factor weighs against a finding of likelihood of confusion.

b. The Parties' Respective Trade Channels Are Not Similar.

Opposer's argument that the parties' trade channels are identical or overlapping is simply wrong, and ignores that Applicant's application is for **downloadable** computer and video games. Opposer's argument that the application does not place specific limitations on the listed goods ignores that the listed goods are "downloadable." Applicant's downloadable Autoduel game will be available for direct download on third party gaming sites such as iTunes and Steam. (37

TTABVUE, pg. 8, ¶ 25.) Opposer's back issues of game supplements, on the other hand, have been available only on www.warehouse23.com.

It is irrelevant where Opposer might sell other games. Opposer's Autoduel products are not games, they are supplements to a board game, and the only place a person has been able to purchase such products for the past ten plus years is on a single website operated by Opposer. There is **no chance** that a consumer would encounter Applicant's downloadable video game and Opposer's pdf Car Wars supplements in the same trade channels

Applicant submits this factor weighs against a finding of likelihood of confusion.

c. The Parties' Respective Marks Are Not Identical.

The parties' marks are not "identical" as Opposer suggests. Applicant seeks registration for "Autoduel" alone. Because Opposer is relying on its common law rights, it is necessary to consider how Opposer uses the mark and compare Opposer's actual uses to Applicant's mark. See, e.g., *In re National Data Corporation*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). The evidence shows that Opposer does not use "autoduel" alone on any of its supplements. (25 TTABVUE Ex. 3 ["Autoduel Champions"]; Ex. 4 ["Autoduel Quarterly"]; Ex. 7 ["GURPS AUTODUEL"]; Ex. 9 ["GURPS Autoduel CAR WARRIORS"]; Ex. 10 ["GURPS Horror/Autoduel"]; **Ex. 11** ["AUTODUEL AMERICA"].)

Applicant submits this factor weighs against a finding of likelihood of confusion.

d. Consumers Do Not Buy Downloadable Video Games on Impulse.

Opposer provides no evidence whatsoever that consumers buy downloadable video games on impulse. Opposer notes the price of its Car Wars game supplements, but presents no evidence as to the expected cost of Applicant's downloadable computer game. Nor does Opposer provide any evidence that potential purchasers of video games are unsophisticated.

The relevant market here is the internet, and "the relevant consumer is a reasonably prudent consumer accustomed to shopping online" *Toyota Motor Sales, USA, Inc. v.*

Tabari, 610 F.3d 1171, 1176 (9th Cir. 2010). “Unreasonable, imprudent and inexperienced web-shoppers are not relevant.” *Id.*

Because Opposer has failed to submit any evidence that the goods are purchased on impulse, this factor weighs against a finding of likelihood of confusion.

e. Opposer’s Mark Is Not Famous and Is Very Weak.

Opposer does not claim that its “autoduel” mark is famous, but does argue that it is “well-known and enjoys substantial goodwill.” (Opp. Br. pg. 28.) The evidence does not support Opposer’s argument.

To begin with, the only products on which Opposer has used the mark for the past twenty years are the twenty to thirty year old back issues of Autoduel Quarterly and other supplements to the Car Wars game. These items have been available for purchase **only** on www.warehouse23.com. From the time Opposer started uploading the supplements to www.warehouse23.com to the time Applicant filed its application, the sales of these supplements were miniscule. (25 TTABVUE, Ex. 13.) Apparently, Opposer does not spend any money or effort on advertising the supplements because Opposer did not present any evidence of such spending.

Additionally, as discussed above, Opposer has used “autoduel” with a more predominant mark, and in a descriptive manner.

Opposer’s contention that it uses the “autoduel” mark on a variety of goods is belied by the fact that the only “uses” consist of selling digitized copies of twenty to thirty year old game supplements on www.warehouse23.com.

Opposer’s contention that “[t]oday, consumers can visit Opposer’s Warehouse23.com online retail store and purchase no less than 50 different products bearing the AUTODUEL mark” (25 TTABVUE 9, ¶ 23) also is misleading. Forty of those items are merely different editions of the 20 to 30 year old Autoduel Quarterly Car Wars supplements. (25 TTABVUE Ex. 13.) Seven of those items are merely different volumes of the 30 year old road atlases. (*Id.*)

The evidence shows that Opposer's mark is very weak. This factor also weighs against a finding of likelihood of confusion.

f. There Is No Evidence of Actual Confusion.

Opposer seeks to rely on hearsay evidence⁷ consisting of comments of persons who, upon learning of Applicant's trademark application for "autoduel," pondered whether Applicant's game would be related to Origin Systems' game from thirty years earlier. However, evidence of persons wondering whether Applicant's game is related to Origin Systems' thirty year old game is not evidence of confusion. See, e.g., *Nora Beverages, Inc. v. Perrier Group of America, Inc.*, 269 F.3d 114, 124 (2d. Cir. 2001)("Inquiries about the relationship between the owner of a mark and an alleged infringer do not amount to actual confusion. Indeed, such inquiries are arguably premised upon a *lack* of confusion between the products such as to inspire the inquiry itself.")(emphasis in original; citations omitted). Moreover, the fact that persons may recall Origin Systems' thirty year old computer game and wonder if Applicant's game has any relation is irrelevant, because Opposer's "uses" of the mark for the past twenty years consist of nothing more than uploading digital copies of twenty to thirty year old Car Wars supplements to www.warehouse23.com.

Opposer's assertion that there has been actual confusion is wrong. Opposer alleges that the confusion started when someone tweeted on October 22, 2015: "'Hell yes' and posted a screenshot of the TSDR page for Applicant's application." (Opp. Br., pg. 25.) However, this does not show confusion. Rather, it shows that whoever posted was well aware that Applicant was not affiliated with Opposer, but was applying for a mark that Opposer's licensee (Origin Systems) had used long ago. In fact, the person who tweeted also asked if Applicant is going to apply for another mark, "2400 A.D." (27 TTABVUE, Ex. 34, pg. SJG000472.) The other comments on which Opposer seeks to rely also do not show confusion. Questions asking

⁷ Applicant has submitted formal objections to the evidence in Appendix I hereto.

whether Applicant is affiliated with Opposer or reminiscing about Opposer's licensee's thirty year old computer game do not show confusion. *Nora Beverages*, 269 F.3d at 124.

The articles Opposer seeks to rely on also recognize that the “autoduel” mark had not been used for more than twenty years. The author of one of the articles noted that the computer version of autoduel “was developed by the long-defunct Origin Systems and released all the way back in 1988.” (27 TTABVue, Ex. 35, pg. SJG000470.) The article further speculates that it would not be unreasonable for Electronic Arts (who had acquired Origin Systems many years ago) “to give [Brian Fargo of Applicant] a shot at a franchise that hasn’t been touched for decades.” (*Id.* at SJG000471.) Others explicitly question whether Opposer abandoned any rights it had in the mark and express doubt that Applicant’s application has any connection to Opposer. (27 TTABVue, Ex. 37, pg. SJG000476.)

Opposer’s evidence shows just the opposite of confusion. The evidence shows that the persons commenting knew who Brian Fargo and Applicant were, and knew the difference between them and Opposer’s and its licensee’s prior uses of the mark. Moreover, speculation as to whether Opposer may have, or previously had, trademark rights in “autoduel” does not establish confusion. “The very fact of calling to mind may indicate that the mind is distinguishing, rather than being confused by, the two marks.” See 4 McCarthy on Trademarks & Unfair Competition § 23:9 (5th ed.) (quoting *Application of Ferrero*, 479 F.2d 1395, 1397 (CCPA 1973); *Groeneveld Transport Efficiency, Inc. v. Lubecore Intern., Inc.*, 730 F.3d 494, 519 (6th Cir. 2013) (“alleging a hypothetical chance that a consumer might think for an instant that two products come from the same source is simply not enough.”); *American Home Products Corp. v. Barr Laboratories, Inc.*, 834 F.2d 368 (3d. Cir. 1987) (survey question asking whether one “associates” the junior user’s product with the senior user’s mark is a doubtful indicator of likely confusion.)

Opposer presented all of the same evidence of alleged actual confusion with its motion for summary judgment, but the Board denied Opposer’s motion on likelihood of confusion and explicitly held that there were genuine issues as to whether there is any evidence of actual

confusion. In its Brief, Opposer simply makes the same arguments, but still has not established that any of the evidence shows actual confusion.

Applicant submits that, at best, the hearsay evidence is vague as to what was in the minds of the persons commenting. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 2016 WL 3915987, * 12 (Trademark Tr. & App. Bd. 2016) (“Without direct testimony from these individuals, there is insufficient information to ascertain what they were thinking, or what caused the purported confusion.”) Opposer has not met its burden to establish actual confusion. This factor weighs against a finding of likelihood of confusion.

g. The Possibility of Confusion Is *De Minimis*, At Most.

As this Board has recognized:

“We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.”

Alliance Technical Services, Inc. v. Alliance Machine Systems International, Inc., 2006 WL 2558023, *14 (Trademark Tr. & App. Bd. 2006) (quoting *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992)).

Given the facts addressed above, any possibility of confusion is *de minimis*, at most. *Alpharma Inc. v. Advanced Animal Nutrition, Inc.*, 2009 WL 273252, *10 (Trademark Tr. & App. Bd. 2009) (“The differences between the goods, channels of trade, and classes of consumers, as well as the relatively sophisticated decision-making in purchasing and using opposer’s products warrant a finding that there is no likelihood of confusion. . . . rather the extent of any possible confusion is *de minimis*.”)

Likewise, Applicant submits that the evidence upon which Opposer relies does not show any actual confusion, but if it does, it is, at most, *de minimis*. *Alliance Technical*, 2006 WL 2558023, *14.

This factor weighs against a finding of likelihood of confusion.

B. Applicant Had A Bona Fide Intent To Use “Autoduel” At The Time It Filed Its Application

1. It Is Opposer’s Burden to Establish Lack of Bona Fide Intent.

Whether an applicant had a bona fide intent to use the mark in commerce at the time of the application requires objective evidence of intent, but the evidentiary bar is not high. *Kelly Services, Inc. v. Creative Harbor, LLC*, 846 F.3d 857, 864 (6th Cir. 2017). The determination must be made on a case-by-case basis based on the totality of the circumstances. *Id.*

The Court in *Kelly Services* provided a nonexclusive list of the types of activities that show a bona fide intent. These include:

- conducting a trademark availability search;
- performing preparatory graphic design work or labeling on sales material for a product;
- using a mark in test marketing;
- testimony regarding informal, unwritten business plans or market research;
- obtaining necessary regulatory permits;
- obtaining a correlative domain name for the mark or setting up a website;
- making contacts with individuals who might help develop a business;
- correspondence mentioning the planned use of the mark;
- attempts to find licensees, including ones outside of the U.S.;
- obtaining commercial space in which to perform the services.

Id. at 865, citing Sandra Edelman, *Proving Your Bona Fides—Establishing Bona Fide Intent to Use Under the U.S. Trademark (Lanham) Act*, 99 Trademark Rptr. 763, 781-82 (2009).

Opposer has the burden to demonstrate by a preponderance of the evidence that inXile lacked a bona fide intent. *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 U.S.P.Q.2d 1581, 2008 WL 4149008, at *6 (Trademark Tr. & App. Bd. 2008). If Opposer meets its initial burden, Applicant must submit evidence to support its bona fide intent. However, the burden of persuasion by a preponderance of the evidence remains with Opposer. *Kelly Services*, 846 F.3d at 865.

It is well-established that documents created after the filing of the application is evidence of intent to use the mark at the time of filing. In *Lane Limited v. Jackson International Trading Company*, 1994 WL 740491, 33 U.S.P.Q.2d (BNA) 1351, 1353 (Trademark Tr. & App. Bd. 1994), for example, the Applicant relied on letters sent **nine to eleven months** after the application was filed to support Applicant's *bona fide* intent. 1994 WL 740491, at *7. The Opposer argued that these letters could not be evidence of Applicant's intent at the time of application. The Board rejected this argument, finding that these letters were sufficiently contemporaneous. The Board held:

“we find that this correspondence, which occurred in October – December 1992, was sufficiently contemporaneous to the application filing date in January 1992 to serve as corroboration of the applicant's declaration in the application of a bona fide intention to use the mark in commerce. Neither the statute nor the Board's decision in *Commodore Electronics* expressly imposes any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention.”

Id. at *19; see also 3 Anne Gilson LaLonde, *Gilson on Trademarks*, § 3.04[2][d] (Matthew Bender) (“The Applicant's documentation need not be contemporaneous with the filing of the intent-to-use application.”) The Board in *Lane* went on to grant summary judgment in Applicant's favor on the issue of bona fide intent. *Id.* at *23.

2. The Evidence Proves Applicant Had a Bona Fide Intent to Use the Mark at the Time of Application.

The facts discussed above establish that Applicant had a bona fide intent to use when it filed the application for “Autoduel.” Among other things, Applicant has conducted a search of the trademark office database for availability, has performed preparatory graphic and other work, has documents and testimony showing business plans, has made contacts with others outside the company who may assist with the Autoduel game, and has internal and external correspondence about plans for the game. The evidence also shows that Applicant conducted a trademark

availability search and, upon learning the mark was available, has filed applications in five counties and the European Union. (37 TTABVUE Fargo Dec., pgs. 3-4, ¶¶ 7-11.) The fact that Applicant's documentary evidence relating to work on Autoduel is dated after the filing of the application is irrelevant.

Opposer notes that Applicant has submitted nine documents relating to Applicant's proposed use of "Autoduel," and argues that this is not enough to show that Applicant intended to use the mark at the time of filing. However, there are many more than nine documents to support Applicant's bona fide intent. The nine exhibits to Mr. Fargo's Testimonial Declaration include, for example email strings, links to other documents, and lengthy attachments. Opposer ignores that the Board has found a bona fide intent on much less. Indeed, in *Lane*, the key documentary evidence consisted of letters to a potential licensee sent nine to twelve months after Applicant had filed the application. *Lane*, 1994 WL 740491, at * 7. Here, there are numerous documents in evidence showing various activity relating to Applicant's planned Autoduel video game, starting three and a half months after Applicant filed the application.

Based on the facts in this case and the applicable precedent, Applicant submits it has established it clearly had a bona fide intent at the time of filing the application. See also *Market America, Inc. v. Luciano Sztulman M.D., Inc.*, 2018 WL 2721906 (Trademark Tr. & App. Bd. 2018).

Opposer's reliance on *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 1993 TTAB LEXIS 6, 26 USPQ2d (BNA) 1503 (Trademark Tr. & App. Bd. 1993) is misplaced. That case merely stands for the proposition that a party may establish a prima facie case of lack of bona fide intent by demonstrating that the other party has **no documentary evidence** demonstrating an intent to use. *Id.* at 1507. Of course, in this case, there is uncontradicted testimony and a significant amount of documentary evidence to establish Applicant's bona fide intent.

VI. CONCLUSION

Applicant respectfully submits that the Opposition should be dismissed, and the Application proceed to registration.

Dated: September 12, 2018

Respectfully submitted,

/s/ Ronald P. Oines

Ronald P. Oines

Lindsay J. Hulley

RUTAN & TUCKER, LLP

611 Anton Boulevard, Fourteenth Floor

Costa Mesa, CA 92626

Telephone: 714-641-5100

Facsimile: 714-546-9035

roines@rutan.com

lhulley@rutan.com

Attorneys for Applicant

APPENDIX I

APPLICANT'S OBJECTIONS TO OPPOSER'S EVIDENCE

Testimonial Declaration of Phil Reed (25 TTABVUE)

Applicant objects to the entirety of paragraphs 11 through 16 of the Reed Declaration, and to Exhibits 13, 14 and 15 on the following grounds: The testimony and exhibits are not based on Mr. Reed's personal knowledge. Fed. R. Ev. 601. The testimony and exhibits lack foundation and are not authenticated. Fed. R. Ev. 901. There is no evidence as to who prepared Exhibits 13, 14 or 15, how they were prepared, or the nature of the documents or records from which the summaries were prepared. Exhibits 13, 14 and 15 are hearsay. Fed. R. Ev. 801, 802.

Applicant objects to Ex. 17 on the grounds that it is hearsay. Fed. R. Ev. 801, 802.

Applicant objects to the following portion of paragraph 39: "Several of these articles used images from the 1985 AUTODUEL computer game, made assumptions that Applicant would be rebooting the 1985 AUTODUEL computer game, referenced Steve Jackson Games, and/or referenced Opposer's CAR WARS game. One image that appears in several articles was used on the game box for both Car Wars Deluxe Edition and the AUTODUEL computer game, both of which were originally released in 1985." These statements are not based on Mr. Reed's personal knowledge (Fed. R. Ev. 601) and lack foundation in that Mr. Reed is purporting to interpret hearsay documents about which he has not personal knowledge.

Applicant objects to paragraph 21 of the Reed Declaration and Exhibit 17 thereto on the grounds that they are hearsay. Fed. R. Ev. 801, 802.

Opposer's Notice of Reliance on Internet Materials (27 TTABVUE)

Applicant objects to Exhibits 33, 34, 35, 36, 37, 38, 39, 40, 41 and 42. These exhibits are hearsay. Fed. R. Ev. 801, 802; *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 2016 WL 3915987, * 12 (Trademark Tr. & App. Bd. 2016) (Inquiries as to whether there was a relationship between junior and senior user are hearsay. "Without direct testimony from these individuals, there is insufficient information to ascertain what they were thinking, or what caused the purported confusion."); *Durrset Amigos, Ltd. d/b/a Amigos Foods v. Amigos Meat*

Distributors, L.P., 2017 WL 5478160, * 9 (Trademark Tr. & App. Bd. 2017) (non-precedential) (same).

Opposer's Notice of Reliance on Discovery Deposition (30 TTABVUE)

Applicant objects to the following pages of Exhibit 52: SJG000472-474; SJG000496-505. These pages are hearsay. Fed. R. Ev. 801, 802; *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 2016 WL 3915987, * 12 (Trademark Tr. & App. Bd. 2016) (Inquiries as to whether there was a relationship between junior and senior user are hearsay. “Without direct testimony from these individuals, there is insufficient information to ascertain what they were thinking, or what caused the purported confusion.”); *Durrset Amigos, Ltd. d/b/a Amigos Foods v. Amigos Meat Distributors, L.P.*, 2017 WL 5478160, * 9 (Trademark Tr. & App. Bd. 2017) (non-precedential) (same).

CERTIFICATION OF ELECTRONIC FILING

I hereby certify that the attached **APPLICANT'S TRIAL BRIEF** was filed electronically with the Trademark Trial and Appeal Board on September 12, 2018.

/s/ Ronald P. Oines

CERTIFICATE OF SERVICE

I hereby certify that a copy of this document entitled **APPLICANT'S TRIAL BRIEF** was served by email on September 12, 2018, such being the Opposer's Domestic Representative and Correspondence as listed on the Notice of Opposition.

Richard J. Groos
Brandon Ress
Samantha M. Ade
KING & SPALDING LLP
401 Congress, Suite 3200
Austin, TX 78701
aotrademark@kslaw.com
rgroos@kslaw.com
BRess@KSLAW.com
sade@kslaw.com
Tel: (512) 457-2046
Fax: (512) 457-2100
ATTORNEYS FOR OPPOSER

/s/ Ronald P. Oines